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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,860	02/11/2004	Wing Sum Vincent Kwan	29617/PM480A	3897

4743 7590 10/19/2006

MARSHALL, GERSTEIN & BORUN LLP
233 S. WACKER DRIVE, SUITE 6300
SEARS TOWER
CHICAGO, IL 60606

EXAMINER

SHOSHO, CALLIE E

ART UNIT PAPER NUMBER

1714

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/776,860

Applicant(s)

KWAN ET AL.

Examiner

Callie E. Shosho

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18, 23 and 24 is/are rejected.
- 7) ☒ Claim(s) 19-22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. All outstanding rejections are overcome by applicants' amendment filed 7/28/06.

The new grounds of rejection set forth below are necessitated by applicants' amendment and thus, the following action is final.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3-5, 8-9, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Okada (U.S. 4,706,669) in view of the evidence given in Wang (U.S. 5,649,999).

Okada discloses color changing composition comprising water, 15-60% pigment including titanium dioxide, triethanolamine, i.e. volatile base, pH indicator such as o-cresolphthalein and thymolphthalein, and polyacrylate. It is disclosed that the pigment also includes calcium carbonate and that mixtures of pigment are utilized. It is well known, as evidenced by Wang (col.3, line 1), that polyacrylate is a film-forming polymer (col.2, lines 38-45, col.3, lines 11-12 and 27-32, col.4, lines 16-17 and 39-41, col.5, lines 30-39, col.5, line 51-col.6, line 12, and col.6, lines 22-26).

While there is no disclosure in Okada that the coloring changing composition is a color changing correction fluid as presently claimed, applicants attention is drawn to MPEP 2111.02 which states that "if the body of a claim fully and intrinsically sets forth all the limitations of the

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claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction". Further, MPEP 2111.02 states that statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the purpose or intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner's position that the preamble does not state any distinct definition of any of the claimed invention's limitations and further that the purpose or intended use, i.e. correction fluid, recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art composition and further that the prior art structure which is a composition identical to that set forth in the present claims is capable of performing the recited purpose or intended use.

In light of the above, it is clear that Okada anticipates the present claims.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada (U.S. 4,170,669) in view of either Keeler (U.S. 4,172,604) or Zabiak (U.S. 4,365,035).

The disclosure with respect to Okada in paragraph 3 above is incorporated here by reference.

The difference between Okada and the present claimed invention is the requirement in the claims of coalescing agent.

Keeler, which is drawn to aqueous coating, discloses the use of coalescent such as glycol ether in order that the composition produce coherent linear film (col.4, lines 43-52).

Alternatively, Zabiak, which is drawn to white ink, disclose the use of glycol ether coalescing agent (col.3, lines 2-10 and col.6, lines 34-36). It would have been within the skill level of one of ordinary skill in the art to recognize that coalescing agent is utilized in order to aid the ink in forming film on substrate.

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use glycol ether coalescing agent in the composition of Okada in order that the composition effectively form film on substrate, and thereby arrive at the claimed invention.

6. Claims 1-5, 8-14, 17-18, and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada (U.S. 4,170,669) in view of Wang (U.S. 5,649,999) and Kawashima (U.S. 4,170,669).

Okada discloses color changing composition comprising water, 15-60% pigment including titanium dioxide, pH indicator such as o-cresolphthalein and thymolphthalein, and polyacrylate. It is disclosed that the pigment also includes calcium carbonate and that mixtures of pigment are utilized. It is well known, as disclosed by Wang (col.3, line 1), that polyacrylate is a

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film-forming polymer (col.2, lines 38-45, col.3, lines 11-12 and 27-32, col.4, lines 16-17 and 39-41, col.5, lines 30-39, col.5, line 51-col.6, line 12, and col.6, lines 22-26).

Okada discloses obtaining marking composition that provides various color marks by adjusting the pH of the composition by adding acid or base to the composition. However, there is no explicit disclosure of the acid or base utilized.

Kawashima, which is drawn to printed matter, disclose using pH indicator, such as cresolphthalein and thymolphthalein, in combination with volatile acid such as acetic acid or formic acid or volatile base such as ammonia so that the printed matter is able to change color (col.2, lines 10-13, 28-34, 38-44, and 56-62, col.3, lines 8-15, 30-38, and 53-68, and col.7, lines 16-19).

While there is no disclosure in Okada or Kawashima that the coloring changing composition is a color changing correction fluid as presently claimed, applicants attention is drawn to MPEP 2111.02 which states that "if the body of a claim fully and intrinsically sets forth all the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction". Further, MPEP 2111.02 states that statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the purpose or intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner's position that the preamble does not state any distinct definition of any of the claimed invention's limitations and further that the purpose or intended use, i.e. correction fluid, recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art composition and further that the prior art structure which is a composition identical to that set forth in the present claims is capable of performing the recited purpose or intended use.

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use acid such as acetic acid or formic acid and volatile base such as ammonia as the acid or base in the composition of Okada so that the composition changes color, and thereby arrive at the claimed invention.

7. Claims 6-7 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada in view of Wang and Kawashima as applied to claims 1-5, 8-14, 17-18, and 23-24 above, and further in view of either Keeler (U.S. 4,172,604) or Zabiak (U.S. 4,365,035).

The difference between Okada in view of Wang and Kawashima and the present claimed invention is the requirement in the claims of coalescing agent.

Keeler, which is drawn to aqueous coating, discloses the use of coalescent such as glycol ether in order that the composition produce coherent linear film (col.4, lines 43-52).

Alternatively, Zabiak, which is drawn to white ink, disclose the use of glycol ether coalescing agent (col.3, lines 2-10 and col.6, lines 34-36). It would have been within the skill level of one of ordinary skill in the art to recognize that coalescing agent is utilized in order to aid ink in forming film on substrate.

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use glycol ether coalescing agent in the composition of Okada in order that the composition effectively form film on substrate, and thereby arrive at the claimed invention.

Allowable Subject Matter

8. Claims 19-22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 19-22 would be allowable in rewritten in independent form as described above for the following reasons.

Okada (U.S. 4,170,669) discloses color changing composition comprising water, 15-60% pigment including titanium dioxide, triethanolamine, i.e. volatile base, pH indicator such as o-cresolphthalein and thymolphthalein, and polyacrylate. However, there is no disclosure of method of correcting an error on a substrate as required in each of present claims 19-22. Further, there is no disclosure of volatile acid as required in present claims 21-22.

Kawashima (U.S. 4,170,669) discloses printed matter comprising pH indicator, such as cresolphthalein and thymolphthalein, and volatile acid such as acetic acid or formic acid or volatile base such as ammonia wherein the printed matter changes color. However, there is no disclosure of method of correcting an error on a substrate as required in each of present claims 19-22.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
10/14/06